

### REMARKS

Applicants respectfully requests reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 13 – 29 are pending. Claim 13 has been amended in response to the rejections under 35 USC 102 and 35 USC 101. It is believed that no new matter has been added.

#### Rejections under 35 USC 102

The Examiner rejected claims 13 – 29 under 35 USC 102(f) as being anticipated by US 6,595,461 (Storbeck et al.). The Examiner found Applicants' invention to be directed to the same invention of Storbeck.

In response, Applicants would remind the Examiner that anticipation requires that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference, and, further, that the absence in the prior art reference of even a single claim element precludes a finding of anticipation. *See In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The identical invention must be shown in as complete detail as is contained in the claim. *See* MPEP 2131. Applicants submit that claim 13 has been amended so that the element "a predetermined length prior to its use in said splicing method" is incorporated into the main body of the claim. The Examiner found "a predetermined length prior to its use in said splicing

method" to not be patentably distinct as evidenced by his rejection under 35 USC 101. Therefore, this portion of the claim has been incorporated into the main body of the claim to make this distinction clear. Accordingly, Applicants submit the claims are not anticipated by Storbeck.

Should the Examiner maintain this rejection, Applicants refer the Examiner to MPEP 706.02(g) which states that "[t]he examiner must presume the applicants are the proper inventors unless there is proof that another made the invention and the applicant derived the invention from the true inventor."

Applicants believe that no proof has been offered to show that the present invention was made by another. In proving derivation under § 102(f), a showing is required wherein:

- (a) the subject matter was conceived in its entirety by another; and
- (b) this conception was communicated to the applicant for patent before the applicant's earliest date of invention.

As no proof of derivation is believed to be provided by the Examiner, the rejection based on 102(f) should be withdrawn.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Rejection under 35 USC 101

Claims 13 – 29 stand rejected under 35 USC 101 in view of Storbeck et al. The Examiner found Storbeck to disclose the same invention and based his rationale on the phrase “a predetermined length prior to its use in said splicing method” is not a meaningful distinction.

In response, Applicants point out that the claims must be co-extensive in scope and claiming identical subject matter. *See In re Vogel*, 164 USPQ 619 (CCPA 1970); *See also* MPEP §804 (“II.A. Statutory Double Patenting- 35 U.S.C. 101”). Applicants do not concede that the phrase “a predetermined length prior to its use in said splicing method” is not a meaningful distinction as alleged by the Examiner, because the fixing label clearly recites that it is a fixing label with the transitional term “having” just prior to “a predetermined length prior to its use in said splicing method”. However, for purposes of making this distinction clear to the Examiner, claim 13 has been amended to bring the phrase into the main body of the claim. Therefore, Applicants submit that Storbeck does not claim identical subject matter, because Storbeck does not claim an adhesive tape which is “a predetermined length prior to its use in said splicing method”.

In view of the foregoing, Applicants submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account  
No. 14-1263.

Respectfully submitted,

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By



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